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| 09/851,533      | 05/08/2001  | Scott J. Fields      |                     | 2600             |

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EXAMINER

ROSEN, NICHOLAS D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3625

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/851,533

Applicant(s)

FIELDS, SCOTT J.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-4 have been examined.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "44" and "46" on the ninth and tenth lines of page 15 are not in the drawings (and in particular, not in Figure 6). The objection to the drawings will not be held in abeyance.

#### ***Specification***

The disclosure is objected to because of the following informalities: Page 19, line 11, has "the existent or non-existence", which should be "the existence or non-existence". Page 21, lines 6 and 7, has "National (which cover all other parts of the world)". Figures 20 and 23 also have "National". This should apparently be "International (which covers all other parts of the world)". Page 22, line 13, has "iffee grids", presumably an error for "fee grids".

Appropriate correction is required.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. The

problem is with "WWW.FEEBID.COM" on the first line of page 15. This could, for example be changed to "www dot feebid dot com".

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: In the third line, "for establish" should be either "to establish" or "for establishing". In the sixth line, "the system" lacks antecedent basis. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: In the fourth and fifth lines, "storing therein a plurality of intellectual property practitioners" should be something like "storing therein data concerning a plurality of intellectual property practitioners", since the practitioners themselves are not stored in the database. Appropriate correction is required.

Claim 4 is objected to because of the following informalities: In the fifth line, "related the nature" should be "related to the nature". In the sixth line, "sercvies" should be "services". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. ("India: 'Mentoring Shop' for Net Cos.") in view of the elance web page of October 12, 1999, Neurath ("Legal Services Matchmaker Struggles") and Wolfe (U.S. Patent 6,282,517). Kumar, in his description of elance.com, discloses, "Buyers put up project requirements on the site and evaluate bids by sellers who bid to provide such services," which implies the existence of a control unit to establish a request generated by a prospective client; means for distributing the request for proposal to service sellers; and means for receiving bids from service sellers who receive the request for proposal. Kumar does not disclose that the service sellers are patent attorneys, or that requests relate to a desire for legal services, but the elance web page lists "LEGAL" as a category and "Patent" as a subcategory, with "RFPs" and "Fixed-Price" listed under the category. Neither Kumar nor the elance web page discloses means for assisting a client in formulating a request for proposal to be distributed to attorneys throughout the system, but Neurath teaches helping clients formulate a request for proposal to be distributed to attorneys (quoted words of Christopher Kane). Neurath does not teach means, other than one or more human beings, for assisting a client in formulating a request for proposal, but Wolfe teaches an apparatus with technical means for helping a user formulate a request (column 3, lines 1-4). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for assisting a client in formulating a request for proposal to be distributed to attorneys throughout the system, for the obvious advantage of having the request for proposal be in clear and usable form.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. ("India: 'Mentoring Shop' for Net Cos.") in view of the elance web page of October 12, 1999, Neurath ("Legal Services Matchmaker Struggles"), Wolfe (U.S. Patent 6,282,517), and official notice. Kumar, in his description of elance.com, discloses, "Buyers put up project requirements on the site and evaluate bids by sellers who bid to provide such services," which implies the existence of a control unit for receiving a request from a prospective client; means for distributing the request for proposal throughout a network (since a dot com site is under discussion) to service sellers; and means for service sellers to respond to the request for proposal with a bid. Kumar does not disclose that the service sellers are intellectual property attorneys, or that requests relate to desired intellectual property law services, but the elance web page lists "LEGAL" as a category and "Patent" as a subcategory, with "RFPs" and "Fixed-Price" listed under the category. Neither Kumar nor the elance web page discloses means for assisting a client in formulating a request for proposal to be distributed to attorneys throughout the system, but Neurath teaches helping clients formulate a request for proposal to be distributed to attorneys (quoted words of Christopher Kane). Neurath does not teach means, other than one or more human beings, for assisting a client in formulating a request for proposal, but Wolfe teaches an apparatus with technical means for helping a user formulate a request (column 3, lines 1-4). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for assisting a client in formulating a request

for proposal to be distributed to attorneys throughout the system, for the obvious advantage of having the request for proposal be in clear and usable form.

Kumar does not expressly disclose means for the prospective client to request additional information from the attorney, but official notice is taken that means for enabling people to request additional information is well known (e.g., e-mail addresses, in conjunction with the Internet, or telephone numbers, in conjunction with the telephone system). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include means for the prospective client to request additional information from the attorney, for the obvious advantage of enabling the prospective to make informed decisions on such questions as which attorney to choose, what services an attorney would provide, etc.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the elance web page of October 12, 1999, in view of Kumar et al. ("India: 'Mentoring Shop' for Net Cos."), and Katz (U.S. Patent 6,323,894). The elance web page discloses providing an interface to the end user of the system to formulate a request for proposal in conjunction with a request for legal services (by listing "LEGAL" as a category and "Patent" as a subcategory, with "RFPs" and "Fixed-Price" listed under the category). The elance web page does not expressly disclose sending out the request for proposal to a plurality of intellectual property practitioners who may respond with bids, but Kumar's description of elance, wherein "Buyers put up project requirements on the site and evaluate bids by sellers who bid to provide such services," implies that requests for

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proposals are sent out to intellectual property practitioners and other appropriate sellers. (This might be done by sending notices to all the potential sellers on a list, whenever a buyer puts up project requirements, or requests for proposals might be sent in response to intellectual property practitioners entering the website and requesting information on RFP's of interest to them; either version would meet the claim language.) The elance web page does not disclose providing a control unit having a database for storing therein data concerning a plurality of intellectual property practitioners, but Katz teaches a database storing data on a plurality of sellers, and sending notices to the sellers by means which include electronic mail (column 4, line 65, through column 5, line 6; column 7, lines 20-22; column 8, lines 45-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to provide a control unit having a database for storing therein data concerning a plurality of intellectual property practitioners, including the practitioners' e-mail addresses, for the obvious advantage (as in Katz) of enabling requests for proposals to be conveniently made available to appropriate practitioners.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. ("India: 'Mentoring Shop' for Net Cos.") in view of the elance web page of October 12, 1999. Kumar, in his description of elance.com, discloses, "Buyers put up project requirements on the site and evaluate bids by sellers who bid to provide such services," which implies the existence of a control unit for establishing a request generated by a prospective client; and means for generating fee quotes based upon the information



provided by the client. Kumar does not disclose that the fee quotes relate to intellectual property law services, but the elance web page lists "LEGAL" as a category and "Patent" as a subcategory, with "RFPs" and "Fixed-Price" listed under the category. The elance web page discloses means for assisting a client in inputting information related to the nature of the desired services (by selecting appropriate an category and subcategory).

### ***Response to Arguments***

Applicant's arguments filed January 21, 2005, have been fully considered but they are not persuasive. Applicant argues that merely because references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Applicant further requests that, if the rejections are maintained, the Examiner identify where the desirability of the combination is found in the prior art.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and particularly with reference to claim 1, Neurath, as cited, specifically teaches assisting users of a

legal services matchmaker in formulating a request for proposal to be distributed to attorneys. Wolfe (column 3, lines 1-4) teaches a technical system (as opposed to the human beings taught in Neurath) for assisting a purchaser in providing the information necessary to create a purchase request. This is taken as teaching of the desirability of having the request for proposal be in clear and usable form; the "Lawyer Selection Advisors" firm described by Neurath would not have had even the hope of a profitable business model by "help[ing] our clients prepare and issue a request for proposal to the selected lawyers," for payment, unless it were desirable, and seen as desirable at the time of Neurath's publication, for such a request for proposal to be well prepared. Similarly, Wolfe's teaching of a Data Center system prompting a buyer to provide information necessary to create the purchase request implies a teaching of the desirability of assisting the buyer to create a purchase request in proper format, so as to be able to be matched to a seller with goods and/or services desired by the buyer, which is the purpose of Wolfe's system.

Moreover, Applicant states that he "submits herewith substitute Figures 1-36(b), in accordance with the Examiner's objection, and the Draftsperson's Patent Drawing Review." However, Examiner has not found these substitute figures in the file.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

### ***Conclusion***

This is a Request for Continued Examination of Applicant's earlier Application No. 09/851,533, which is a Continuation-in-Part of Applicant's earlier Application No. 09/710,779. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number

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for the organization where this application or proceeding is assigned is 703-872-9306.

Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN  
PRIMARY EXAMINER**

February 7, 2005